

7-26-02

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference GEM656	<b>FOR FURTHER ACTION</b> See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)	
International application No. PCT/FR00/01488	International filing date (day/month/year) 30 May 2000 (30.05.00)	Priority date (day/month/year) 15 June 1999 (15.06.99)
International Patent Classification (IPC) or national classification and IPC C08G 63/02		
Applicant GEMPLUS		

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1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.
2. This REPORT consists of a total of 6 sheets, including this cover sheet.  
☒ This report is also accompanied by ANNEXES, i.e., sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).

These annexes consist of a total of 6 sheets.

3. This report contains indications relating to the following items:

- I ☒ Basis of the report
- II ☐ Priority
- III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- IV ☒ Lack of unity of invention
- V ☒ Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI ☐ Certain documents cited
- VII ☐ Certain defects in the international application
- VIII ☐ Certain observations on the international application

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Date of submission of the demand 03 January 2001 (03.01.01)	Date of completion of this report 18 September 2001 (18.09.2001)
Name and mailing address of the IPEA/EP	Authorized officer
Facsimile No.	Telephone No.

## INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/FR00/01488

## I. Basis of the report

1. With regard to the **elements** of the international application:\*

- ☐ the international application as originally filed
- ☒ the description:  
pages 1-31, as originally filed  
pages \_\_\_\_\_, filed with the demand  
pages \_\_\_\_\_, filed with the letter of \_\_\_\_\_
- ☒ the claims:  
pages \_\_\_\_\_, as originally filed  
pages \_\_\_\_\_, as amended (together with any statement under Article 19  
pages \_\_\_\_\_, filed with the demand  
pages 1-17, filed with the letter of 03 September 2001 (03.09.2001)
- ☒ the drawings:  
pages 1/14-14/14, as originally filed  
pages \_\_\_\_\_, filed with the demand  
pages \_\_\_\_\_, filed with the letter of \_\_\_\_\_
- ☐ the sequence listing part of the description:  
pages \_\_\_\_\_, as originally filed  
pages \_\_\_\_\_, filed with the demand  
pages \_\_\_\_\_, filed with the letter of \_\_\_\_\_

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language \_\_\_\_\_ which is:

- ☐ the language of a translation furnished for the purposes of international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of the translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. ☐ The amendments have resulted in the cancellation of:

- ☐ the description, pages \_\_\_\_\_
- ☐ the claims, Nos. \_\_\_\_\_
- ☐ the drawings, sheets/fig \_\_\_\_\_

5. ☒ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).\*\*

\* Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rule 70.16 and 70.17).

\*\* Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.

**I. Basis of the report**

1. This report has been drawn on the basis of *(Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to the report since they do not contain amendments.)*:

Continuation of: Box I.5

The disclaimer inserted into Claim 1 is not acceptable because, in order to establish novelty, it should exclude only the subject matter that is disclosed in the prior art (namely, a copolyester based on tartaric acid, citric acid and a diol), not an entire monomer group.

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/FR00/01488

IV. Lack of unity of invention

1. In response to the invitation to restrict or pay additional fees the applicant has:

- ☐ restricted the claims.
- ☐ paid additional fees.
- ☐ paid additional fees under protest.
- ☐ neither restricted nor paid additional fees.

2. ☒ This Authority found that the requirement of unity of invention is not complied with and chose, according to Rule 68.1, not to invite the applicant to restrict or pay additional fees.

3. This Authority considers that the requirement of unity of invention in accordance with Rules 13.1, 13.2 and 13.3 is

- ☐ complied with.
- ☒ not complied with for the following reasons:

**SEE SEPARATE SHEET**

4. Consequently, the following parts of the international application were the subject of international preliminary examination in establishing this report:

- ☒ all parts.
- ☐ the parts relating to claims Nos. \_\_\_\_\_

**Supplemental Box**

(To be used when the space in any of the preceding boxes is not sufficient)

Continuation of: IV.3

The various groups of inventions are as follows:

1. Claims 1, 2 and 9
2. Claims 1, 2 and 10
3. Claims 1, 2 and 15
4. Claims 1, 2 and 16
5. Claims 1, 2 and 17
6. Claims 1, 2 and 18

These groups of inventions are not so linked as to form a single general inventive concept (PCT Rule 13.1) for the following reasons:

The feature common to these 6 groups of inventions is a copolymer containing citric acid as one of the monomers. A copolymer of this kind is described in document US-A-5 217 642 (D1). It follows that the 6 groups of inventions do not form a single general inventive concept.

**V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement****1. Statement**

Novelty (N)	Claims	3-18	YES
	Claims	1, 2	NO
Inventive step (IS)	Claims		YES
	Claims	1, 2	NO
Industrial applicability (IA)	Claims	1-18	YES
	Claims		NO

**2. Citations and explanations**

Reference is made to the following document:

D1: US-A-5 217 642 (A. KUD ET AL) 8 June 1993  
(1993-06-03)

Document D1 describes a copolyester based on tartaric acid, citric acid and a diol (for example, polyalkylene glycol). These copolymers are highly biodegradable. It follows that the subject matter of Claims 1 and 2 is not novel.